

Remarks

Claims 1-30 are pending. Claims 28-30 have been added. Entry of the amendment is respectfully requested. No new matter has been added. Reconsideration is respectfully requested.

Claim Status

Claims 1-8, 12, 14, and 26-27 were rejected as obvious pursuant to 35 U.S.C. § 103(a) over Isozaki (US 4,919,058) in view of Gardner (US 5,929,413).

Claim 14 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Isozaki/Gardner in view of Beck (US 4,612,864).

Claim 24 was rejected as obvious pursuant to 35 U.S.C. § 103(a) over Isozaki/Gardner in view of Mair (US 6,367,695).

Claims 9-11, 13, 15-23, and 25 were indicated allowable if written in an independent form. Indication of allowable subject matter is greatly appreciated.

The Rejections

The Applicants respectfully traverse the rejections. It is unclear whether claim 14 is rejected over Isozaki/Gardner (Action page 3) or Isozaki/Gardner/Beck (Action page 7). Likewise, it is unclear whether claims 26-27 are rejected over Isozaki/Gardner (Action page 3) or Isozaki/Gardner/Beck (Action page 8).

Claim 1

The Action (on page 4) admits that Isozaki/Gardner does not teach or suggest moving a card reader with a card holding bin operatively engaged therewith. The Action alleges that "making the holding bin integral would have been a matter of obvious design choice." The record lacks substantial evidence support for the rejection. The assertion is not based on any evidence of record. The Patent Office is not permitted to rely merely on unsupported assertions as the basis for rejecting claims. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001). *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002). Thus, the rejection (which relies on the assertion) is not valid.

Applicants challenge the Action's assertion. Nor are Gardner's card reader (60) and bin (80) "rigidly secured together as part of a single system", as alleged at Action page 5. Gardner's teaching is concrete evidence that is contrary to the Action's mere assertion. Gardner teaches that the "bin 80 adjoins the card reader 60, as shown in FIG. 3" (col. 3, lines 58-59). That is, the bin (80) is separate from the card reader (60). The bin and card reader would be moved separately, and therefore not in the manner recited.

The Office has provided no teaching or suggestion for attaching a card reader to a card holding bin, as alleged (page 5). Nor has the Office provided any teaching or suggestion for making a bin and a card reader an integral (bulky) component as alleged (page 4), especially in light of the tight confines within an ATM. One skilled in the art would look to simplify handling of and provide easier access to ATM components, contrary to the Action's assertion.

The only teaching of providing the recited card reader and card holding bin relationship is found in Applicants' own disclosure. Nor does Isozaki/Gardner have any need or desire for the

recited relationship. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed Cir. 1990). The rejection is based solely on hindsight reconstruction of Applicants' invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992).

The references, taken alone or in combination, do not teach or suggest the recited features and relationships. The Office has not established a *prima facie* case of obviousness.

Claim 28

The references, taken alone or in combination, do not teach or suggest a card capture bin having an upper lid in the manner recited. Nor do the references teach or suggest moving the bin lid to an open position to enable removal of captured cards from the bin.

Isozaki/Gardner does not teach or suggest a bin lid. The Action (at page 4) admits that Isozaki does not even teach or suggest a bin, let alone a bin lid. There is good reason why Gardner does not have a bin lid. Gardner has a top wall (82) which appears to be one piece with at least one (81) of the side walls (col. 3, lines 58-61). Further, Gardner's solenoid (94) is fixedly mounted to the top wall (82) (col. 5, lines 36-40). Also, Gardner's support piece (92) connects the top wall (82) to the extending portion (90), which itself is fixedly connected to the side wall (81) (col. 5, lines 23-30). The Action is silent as to how a lid in Gardner could provide the necessary structural support for the fixed fraud tool (99) assembly and still be openable. The Action is also silent as to how the blocking location of Gardner's fraud tool assembly would enable the removal of a card from the bin via an open lid. The structure of Gardner teaches against having a bin lid that when open enables the removal of captured cards from the bin. It

would not have been obvious to one having ordinary skill in the art to have modified Isozaki/Gardner with a bin lid in the manner recited.

Claim 29

Claim 29 has been drafted to include the features indicated allowable in claim 9. Thus, Applicants respectfully submit that claim 29 is allowable.

Claim 30

Claim 30 is an apparatus claim that includes features that correspond to method claims indicated as allowable.

The Dependent Claims

The applied art also does not teach or suggest the recited dependent claims. Each of the dependent claims depends directly or indirectly from an independent claim. The Applicants have shown the independent claims to be allowable. Thus, it is asserted that the dependent claims are allowable on the same basis. Furthermore, each dependent claim additionally recites specific features and relationships that further patentably distinguish the claimed invention over the applied art. The references, taken alone or in combination, do not teach or suggest the recited features and relationships. For example, the references also do not teach or suggest the recited lid and lock relationship of claim 23. The Action has not established a *prima facie* case of obviousness.

Fee For Additional Claims

Please charge the fee associated with the submission of three additional total claims (\$150) and one additional independent claim (\$200) and any other fee due to Deposit Account 09-0428.

Conclusion

Applicants respectfully submit that this application is in condition for allowance.

The undersigned will be happy to discuss any aspect of the Application by telephone at the Office's convenience.

Respectfully submitted,


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